

REMARKS**SUMMARY:**

Claims 1-4, 7-9, 12-15, 18-20, 23-26, and 29-31 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Raman in view of Damiani. Claims of the present application claim methods, systems, and products for creating a presentation document that includes, among other limitations, creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes an identifier for at least one structural element of the structured document. In the specification, Applicants state that the presentation document includes a presentation grammar and a structured document. Applicants further define the presentation grammar as a data structure that includes a set of key phrases used to identify presentation action identifiers and optional parameters for use in formulating presentation control instructions relevant to structural elements of a content type. The Office Action attempts to equate a common intermediate representation of Raman with a presentation document as claimed in the present application. In contrast to a presentation document, however, nowhere does Raman teach or suggest that the common intermediate representation includes a presentation grammar. The Office Action further attempts to equate control signals and navigational methods with a presentation grammar. In contrast to a presentation grammar, however, nowhere does Raman teach or suggest that the control signals or navigational methods include grammar elements each of which includes an identifier for at least one structural element of the structured document. As such, Raman does not teach or suggest a presentation grammar or a presentation document that includes a presentation grammar. Moreover, Damiani is not concerned with grammars and, therefore, does not teach or suggest a presentation grammar or a presentation document that includes a presentation grammar.

DETAILED ANALYSIS:**DOUBLE PATENTING REJECTIONS**

Claims 1, 8-12, 18-23, and 29-33 are provisionally rejected on the ground of non-statutory double patenting over claims 1, 3, 4, 7-12, 15-20, and 23 of co-pending Application No. 10/734,764. In response, Applicants herewith submit a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321 for the present application to cure the double patenting rejections in the present application.

GENERAL COMMENTS REGARDING CLAIM TERMINOLOGY

The Office Action at pages 6 through 9 attempts to define various terms and phrases used in the claims of the present application such as ‘presentation document,’ ‘structured document,’ ‘structural identifiers,’ ‘structural element identifiers,’ ‘structural elements,’ ‘classifying structural elements,’ ‘presentation attribute,’ ‘presentation grammar,’ ‘grammar elements,’ and ‘user grammar elements.’ Applicants respectfully point out that, during prosecution, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). When interpreting the claims as broadly as their terms reasonably allow, the words of the claims must be given their plain meaning unless Applicants have provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir. 2004).

Regarding several of the terms mentioned above, Applicants have in fact provided definitions in the specification. In the summary of the invention in the original specification at page 2, lines 4-5, Applicants clearly describe a presentation document to include a presentation grammar and a structured document. In the original specification at page 9, lines 19-22, Applicants clearly define a presentation grammar as a data

structure that includes a set of key phrases used to identify presentation action identifiers and optional parameters for use in formulating presentation control instructions relevant to structural elements of a content type. In the original specification at page 9, lines 11-14, Applicants clearly define presentation attributes as generic selection criteria for displaying appropriate structural elements of original documents to users. Because Applicants have provided clear definitions for these terms, such definitions will control interpretation of the term as it is used in the claim. *Manual of Patent Examination and Procedure* § 2106 II C; *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999).

Regarding the other terms mentioned above, the words of the claims must be given their plain meaning. The plain meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention. *Manual of Patent Examination and Procedure* § 2111.01 II (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (en banc); *Sunrize Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003)). To aid the Examiner in determining the meaning that these terms would have to a person of ordinary skill in the art at the time of the invention, the Applicants have provided a specification of 81 pages that includes 18 sheets of drawings. Subject to these comments, however, Applicants respectfully decline to interpret claim terms further in view of the risk of prosecution history estoppel within the meaning of *Festo Corp. v. Shoketsu Kinzoku Kogyokabushiki Co.*, 122 S. Ct. 1831, 535 U.S. 722, 152 L. Ed. 2d 944, 62 U.S.P.Q.2d 1705 (2002). The MPEP, as cited above, provides the Examiner with a sufficient framework for claim interpretation. Applicants' make no admissions whatsoever regarding any particular interpretation of the claims. Applicants are entitled to and encourage the interpretation of claims as broadly as their terms reasonably allow to encompass all consistent meanings.

CLAIM REJECTIONS – 35 U.S.C. § 103 OVER RAMAN IN VIEW OF DAMIANI

Claims 1-4, 7-9, 12-15, 18-20, 23-26, and 29-31 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Raman (U.S. Patent No. 5,748,186) in view of Damiani, *et al.* (“A Fine-Grained Access Control System for XML Documents,” *ACM Transaction on Information and System Security*, Vol. 5, No. 2, May 2002, pages 169-202). To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* § 2142. The first element of a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of Raman and Damiani must teach or suggest all of Applicants’ claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The second element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine Raman and Damiani. *In re Vaack*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The third element of a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of Raman and Damiani. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). As demonstrated below, the proposed combination of Raman and Damiani does not establish a prima facie case of obviousness. The rejection of claims 1-4, 7-9, 12-15, 18-20, 23-26, and 29-31 should therefore be withdrawn and the case should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 1-4, 7-9, 12-15, 18-20, 23-26, and 29-31.

The Proposed Combination Of Raman And Damiani Does Not Teach Or Suggest All Of The Claim Limitations Of Applicants’ Claims

To establish a prima facie case of obviousness, the proposed combination of Raman and Damiani must teach or suggest all of the claim limitations of dependent claims 1-4, 7-9, 12-15, 18-20, 23-26, and 29-31. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). As Applicants will demonstrated below, the proposed combination of Raman and Damiani does not teach or suggest each and every element of independent

claim 1, and the proposed combination of Raman and Damiani, therefore, does not establish a prima facie case of obviousness within the meaning of 35 U.S.C. § 103.

Independent claim 1 of the present application claims:

1. A method for creating a presentation document, the method comprising:

 creating, in dependence upon an original document, a structured document comprising one or more structural elements;

 classifying a structural element of the structured document according to a presentation attribute; and

 creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes an identifier for at least one structural element of the structured document.

The Combination of Raman And Damiani Does
Not Teach Or Suggest Creating A Presentation Document

Claim 1 claims a method for “creating a presentation document.” In the summary of the invention at page 2, lines 3-5, of the original application, Applicants state that a presentation document includes a presentation grammar and a structured document. A presentation grammar is a data structure that includes a set of key phrases used to identify presentation action identifiers and optional parameters for use in formulating presentation control instructions relevant to structural elements of a content type. *See Original Specification* at page 9, lines 19-22. Applicants respectfully note that Damiani does not teach or suggest a presentation document that includes a presentation grammar and a structured document. Damiani discloses a fine-grained access control system for XML documents that has nothing whatsoever to do with a grammar. In fact, nowhere in the

cited portions of Damiani does the reference ever mention or suggest a grammar. Damiani, therefore, cannot teach or suggest a presentation document that includes a presentation grammar and a structured document.

Furthermore, Applicants respectfully note that Raman also does not teach or suggest a presentation document that includes a presentation grammar and a structured document. In an effort to demonstrate that Raman teaches a presentation document, the Office Action attempts to equate Raman's common intermediate representation with a presentation document as claimed in the present application. A common intermediate representation, however, is a hierarchical attribute tree having a plurality of document objects. *See* Raman at column 2, lines 27-35. The document objects of Raman represent the document, the structure of the document, and procedures which can operate on the document. *Id.* The common intermediate representation is presented using a plurality of user modalities such as, for example, aural, visual, and tactile modalities. *Id.* Nowhere in Raman, however, does Raman teach that the common intermediate representation includes a grammar. In fact, Raman never even once mentions the term 'grammar.' Furthermore, even if Raman suggests a grammar, Raman at column 3, lines 30-35, suggests that such a grammar would be contained in the interactive interface—not the common intermediate representation. Raman at column 3, lines 30-35, states:

An interactive interface 150 coupled to I/O devices 160 can be used to control the retriever 120 and the presenter 140. The I/O devices 160 can include a monitor, a keyboard, a mouse, a telephone key-pad, a voice input unit coupled to a speech recognizer, and a speech synthesizer.

Raman's presenter converts the common intermediate representation into multimodal presentations as directed by the user. *See* Raman at column 3, lines 8-13. According to the quoted portion of Raman above, Raman's interactive interface may control the presenter through recognized speech. To control the manner in which the presenter presents the common intermediate representation, Raman's interactive interface may use a grammar that associates recognized speech with actions to be performed by the presenter. Therefore, even if Raman suggests a grammar, Raman suggests that the

grammar is included in the interactive interface of Raman—not the common intermediate representation. Because neither Raman nor Damiani teaches or suggests a presentation document that includes a presentation grammar and a structured document, the proposed combination of Raman and Damiani does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

The Combination of Raman And Damiani Does Not Teach Or Suggest Creating A Presentation Grammar For The Structured Document, Wherein The Presentation Grammar For The Structured Document Includes Grammar Elements Each Of Which Includes An Identifier For At Least One Structural Element Of The Structured Document

The third element of claim 1 claims “creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes an identifier for at least one structural element of the structured document.” Regarding the third element of claim 1, the Office Action at page 4 states that Raman at column 2, lines 36-45, column 6, lines 30-33, column 3, lines 30-34, column 5, lines 38-46, claim 1, lines 13-15, column 4, lines 22-27, discloses:

creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes an identifier for at least one structural element of the structured document. (See, Raman, col. 2, lines 36-45, teaching the use of “control signals” as “presentation grammar” to control the modality being used to control the presentation. See, Raman, col. 6, lines 30-33, teaching that a control signal may include recognized speech as an input. See, also Raman, col. 3, lines 30-34, teaching that the data retriever and the presenter of the system may be controlled by voice recognized input couple to a speech recognizer. And see, Raman, col. 5, lines 38-46, teaching “navigational methods associated with objects allow the user to browse through the text by taking into consideration the underlying structure of the document.” And see, Raman, claim 1, lines 13-15, teaching “presenting the common intermediate representation using a plurality of user communications modalities according to the hierarchical attribute trees.” And see, Raman, col. 4, lines 22-27, teaching speech response to aural presentation of stock data. For each type of speech response, it is inherent that there be an associated grammar.)

That is, the Office Action takes the position that Raman at column 2, lines 36-45, column 6, lines 30-33, column 3, lines 30-34, column 5, lines 38-46, claim 1, lines 13-15, column 4, lines 22-27, discloses the third element of claim 1. Applicants respectfully note in response that what Raman at column 2, lines 36-45, in fact discloses is:

While presenting the information, the method receives control signals from a user using the plurality of user communication modalities. The control signals enable the user to interactively and independently control the receiving of the information and the presentation of the information in a plurality of presentation modalities.

As an advantage, the user can browse through the document taking the structure of the document into consideration. In addition, the user can control the presentation modality that is being used to render the document.

That is, Raman at column 2, lines 36-45, discloses receiving control signals from a user that enable the user to interactively and independently control the receiving of the information and the presentation of the information in a plurality of presentation modalities. The Office Action attempts to equate receiving control signals from a user with creating a presentation grammar as claimed in the present application. Applicants respectfully point out from claim 1 that the presentation grammar includes grammar elements each of which includes an identifier for at least one structural element of the structured document. Raman, however, never even once mentions or suggests that Raman's control signals include grammar elements each of which includes an identifier for at least one structural element of a structured document. In fact, Raman at column 2, lines 36-45, does not even mention 'grammar,' 'presentation grammar,' 'grammar elements,' 'grammar elements each of which includes an identifier for at least one structural element of the structured document,' or 'creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes an identifier for at least one structural element of the structured document.' Because the combination of Raman and Damiani does not teach or suggest each and every element and limitation of Applicants' claims,

the proposed combination of Raman and Damiani does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to Raman at column 6, lines 30-33, Applicants respectfully note in response that what Raman at column 6, lines 30-33, in fact discloses is:

Control signals or events can include key strokes, mouse clicks, or other user input, including recognized speech. Events can have associated priorities. An event with a higher priority may preempt the processing of lower priority events.

That is, Raman at column 6, lines 30-33, discloses that control signals or events may be implemented as user input and that events may have associated priorities. Again, the Office Action attempts to equate control signals from a user with a presentation grammar as claimed in the present application. As mentioned above, claim 1 clearly indicates that the presentation grammar includes grammar elements each of which includes an identifier for at least one structural element of the structured document. Raman, however, never even once mentions or suggests that Raman's control signals include grammar elements each of which includes an identifier for at least one structural element of a structured document. In fact, Raman at column 6, lines 30-33, does not even mention 'grammar,' 'presentation grammar,' 'grammar elements,' 'grammar elements each of which includes an identifier for at least one structural element of the structured document,' or 'creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes an identifier for at least one structural element of the structured document.' Because the combination of Raman and Damiani does not teach or suggest each and every element and limitation of Applicants' claims, the proposed combination of Raman and Damiani does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to Raman at column 3, lines 30-34, Applicants respectfully note in response that what Raman at column 3, lines 30-34, in fact discloses is:

An interactive interface 150 coupled to I/O devices 160 can be used to control the retriever 120 and the presenter 140. The I/O devices 160 can include a monitor, a keyboard, a mouse, a telephone key-pad, a voice input unit coupled to a speech recognizer, and a speech synthesizer.

That is, Raman at column 3, lines 30-34, discloses an interactive interface connected to I/O devices for receiving control signals. The Office Action continues to use Raman's controls signal in an effort to demonstrate that Raman teaches or suggests creating a presentation grammar. The Office Action attempts to equate receiving control signals from a user with creating a presentation grammar as claimed in the present application. As mentioned above, the presentation grammar includes grammar elements each of which includes an identifier for at least one structural element of the structured document. Raman, however, never even once mentions or suggests that Raman's control signals include grammar elements each of which includes an identifier for at least one structural element of a structured document. In fact, Raman at column 3, lines 30-34, does not even mention 'grammar,' 'presentation grammar,' 'grammar elements,' 'grammar elements each of which includes an identifier for at least one structural element of the structured document,' or 'creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes an identifier for at least one structural element of the structured document.' Because the combination of Raman and Damiani does not teach or suggest each and every element and limitation of Applicants' claims, the proposed combination of Raman and Damiani does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to Raman at column 5, lines 38-46, Applicants respectfully note in response that what Raman at column 5, lines 38-46, in fact discloses is:

Navigational methods associated with objects allow the user to browse through the text taking the underlying structure of the document 111 into consideration. As an advantage, the object can be rendered or viewed in a plurality of presentation modalities, e.g., visible, audible, tactile. Multiple modalities can be presented concurrently in a synchronized manner, and

according to a predetermined style to facilitate the comprehension of the presented information.

That is, Raman at column 5, lines 38-46, discloses navigational methods associated with objects that allow a user to browse through the text of a document taking the underlying structure of the document into consideration. The Office Action attempts to equate navigational methods with a presentation grammar as claimed in the present application. As mentioned above, Applicants point out in the original specification at page 9, lines 19-22, that a presentation grammar is a data structure that includes a set of key phrases used to identify presentation action identifiers and optional parameters for use in formulating presentation control instructions relevant to structural elements of a content type. Raman's navigational methods, however, are executable computer program instructions—not data structures. In addition, Applicants respectfully point out from claim 1 that the presentation grammar includes grammar elements each of which includes an identifier for at least one structural element of the structured document. Raman, however, never even once mentions or suggests that Raman's navigational methods include grammar elements each of which includes an identifier for at least one structural element of a structured document. In fact, Raman at column 5, lines 38-46, does not even mention 'grammar,' 'presentation grammar,' 'grammar elements,' 'grammar elements each of which includes an identifier for at least one structural element of the structured document,' or 'creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes an identifier for at least one structural element of the structured document.' Because the combination of Raman and Damiani does not teach or suggest each and every element and limitation of Applicants' claims, the proposed combination of Raman and Damiani does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to Raman at claim 1, lines 13-15, Applicants respectfully note in response that what Raman at claim 1, lines 13-15, in fact discloses is:

presenting the common intermediate representation using a plurality of user communication modalities according to the hierarchical attribute tree....

That is, Raman at claim 1, lines 13-15, discloses presenting the common intermediate representation using a plurality of user communication modalities according to the hierarchical attribute tree. Raman's presenting the common intermediate representation using a plurality of user communication modalities according to the hierarchical attribute tree clearly is not creating a presentation grammar for the structured document as claimed in the present application. As mentioned above, Raman's common intermediate representation neither is nor includes a presentation grammar. Moreover, Applicants respectfully point out from claim 1 that the presentation grammar includes grammar elements each of which includes an identifier for at least one structural element of the structured document. Raman, however, never even once mentions or suggests that Raman's common intermediate representation includes grammar elements each of which includes an identifier for at least one structural element of a structured document. In fact, Raman at claim 1, lines 13-15, does not even mention 'grammar,' 'presentation grammar,' 'grammar elements,' 'grammar elements each of which includes an identifier for at least one structural element of the structured document,' or 'creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes an identifier for at least one structural element of the structured document.' Because the combination of Raman and Damiani does not teach or suggest each and every element and limitation of Applicants' claims, the proposed combination of Raman and Damiani does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

Turning now to Raman at column 4, lines 22-27, Applicants respectfully note in response that what Raman at column 4, lines 22-27, in fact discloses is:

The forms 115 are used to conduct a dialogue with the user. In the preferred embodiment of the invention, the user can select to interact with the forms 115 using speech. For example, the forms 115 can be used to get a stock or a financial transaction. The system can say the prompts of the

transaction, and the user input can be processed by the speech input unit of the I/O 160.

That is, Raman at column 4, lines 22-27, discloses forms used to conduct a dialogue with the user. Raman's forms used to conduct a dialogue with the user clearly is not creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes an identifier for at least one structural element of the structured document as claimed in the present application. As mentioned above, a presentation grammar includes grammar elements each of which includes an identifier for at least one structural element of the structured document. Raman, however, never even once mentions or suggests that Raman's forms used to conduct a dialogue with the user include grammar elements each of which includes an identifier for at least one structural element of a structured document. In fact, Raman at column 4, lines 22-27, does not even mention 'grammar,' 'presentation grammar,' 'grammar elements,' 'grammar elements each of which includes an identifier for at least one structural element of the structured document,' or 'creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes an identifier for at least one structural element of the structured document.' Because the combination of Raman and Damiani does not teach or suggest each and every element and limitation of Applicants' claims, the proposed combination of Raman and Damiani does not establish a prima facie case of obviousness, and the rejections should be withdrawn.

There Is No Suggestion Or Motivation To
Combine Raman and Damiani

To establish a prima facie case of obviousness, there must be a suggestion or motivation to combine Raman and Damiani. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, obviousness cannot be established unless one having ordinary skill

in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention by doing what the applicant has done. *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) (citing, for example, *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985) (emphasis added)). That is, the suggestion or motivation to combine Raman and Damiani must be a suggestion or motivation to combine Raman and Damiani that arrives at the claimed invention by doing what the Applicants have done.

Applicants claim methods, systems, and products for creating a presentation document that includes, among others, the limitations of creating a presentation grammar for the structured document, wherein the presentation grammar for the structured document includes grammar elements each of which includes an identifier for at least one structural element of the structured document. As demonstrated above, neither Raman nor Damiani discloses these limitations and cannot, therefore, provide a suggestion or motivation that arrives at the claimed invention by doing what the applicants have done. Because the Office Action cannot provide evidence of the suggestion or motivation that arrives at the claimed invention by doing what the Applicants have done, the Office Action does not establish a prima facie case of obviousness, the rejections should be withdrawn, and the claims should be allowed.

Relations Among Claims

Independent claim 1 is patentable for the reasons discussed above. Independent claims 12 and 23 claim system and computer program product aspects of the method claimed in independent claim 1. Independent claims 12 and 23 therefore are patentable for the same reasons that claim 1 is patentable as described above. Dependent claims 2-4 and 7-9 depend from independent claim 1. Dependent claims 13-15 and 18-20 depend from independent claim 12. Dependent claims 24-26 and 29-31 depend from independent claim 23. The dependent claims include each and every element and limitation of the independent claims from which they depend. The dependent claims stand because their

respective independent claims stand. Claims 1-4, 7-9, 12-15, 18-20, 23-26, and 29-31 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-4, 7-9, 12-15, 18-20, 23-26, and 29-31.

**CLAIM REJECTIONS – 35 U.S.C. § 103 OVER RAMAN
IN VIEW OF DAMIANI IN FURTHER VIEW OF JOSEPHSON**

Claims 5-6, 10-11, 16-17, 21-22, 27-28, and 32-33 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Raman (U.S. Patent No. 5,748,186) in view of Damiani, *et al.* (“A Fine-Grained Access Control System for XML Documents,” *ACM Transaction on Information and System Security*, Vol. 5, No. 2, May 2002, pages 169-202) in further view of Josephson (U.S. Patent Publication 2003/023435 A1). The rejections of claims 5-6, 10-11, 16-17, 21-22, 27-28, and 32-33 rely on the previous 35 U.S.C. § 103 rejection arguing that the combination of Raman and Damiani teaches or suggests each and every element and limitation of independent claims 1, 12, and 23. Applicants have demonstrated above that the combination of Raman and Damiani does not disclose each and every element of independent claims 1, 12, and 23.

To establish a *prima facie* case of obviousness, the proposed combinations of the references must teach or suggest all of the claim limitations of dependent claims 5-6, 10-11, 16-17, 21-22, 27-28, and 32-33. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Dependent claims 5-6, 10-11, 16-17, 21-22, 27-28, and 32-33 depend from independent claims 1, 12, and 23 respectively and include all of the limitations of the claims from which they depend. Because the proposed combinations rely on the argument that the combination of Raman and Damiani teaches each and every element claims 1, 12, and 23, and because the combination of Raman and Damiani in fact does not teach or suggest each and every element of claim 1, 12, and 23, the proposed combination of Raman, Damiani, and Josephson cannot teach or suggest all the claim limitations of claims 5-6, 10-11, 16-17, 21-22, 27-28, and 32-33. The proposed combinations therefore cannot establish a *prima facie* case of obviousness and the rejections should be withdrawn.

CONCLUSION

Claims 1, 8-12, 18-23, and 29-33 are provisionally rejected on the ground of non-statutory double patenting over claims 1, 3, 4, 7-12, 15-20, and 23 of co-pending Application No. 10/734,764. Applicants respectfully propose that the accompanying Terminal Disclaimer cures the rejections of claims 1, 8-12, 18-23, and 29-33 in the present application on the grounds of non-statutory double patenting.

Claims 1-4, 7-9, 12-15, 18-20, 23-26, and 29-31 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Raman in view of Damiani. For the reasons set forth above, however, the proposed combination of Raman and Damiani, however, does not establish a prima facie case of obviousness. The rejection of claims 1-4, 7-9, 12-15, 18-20, 23-26, and 29-31 should therefore be withdrawn, and the claims should be allowed. Reconsideration of claims 1-4, 7-9, 12-15, 18-20, 23-26, and 29-31 in light of the present remarks is respectfully requested.


Claims 5-6, 10-11, 16-17, 21-22, 27-28, and 32-33 stand rejected for obviousness under 35 U.S.C § 103(a) as being unpatentable over Raman in view of Damiani in further view of Josephson. Because the proposed combinations rely on the argument that the combination of Raman and Damiani teaches each and every element claims 1, 12, and 23, and because the combination of Raman and Damiani in fact does not teach or suggest each and every element of claim 1, 12, and 23, the proposed combination of Raman, Damiani, and Josephson cannot teach or suggest all the claim limitations of claims 5-6, 10-11, 16-17, 21-22, 27-28, and 32-33. The proposed combination of Raman, Damiani, and Josephson, therefore, cannot establish a prima facie case of obviousness and the rejections should be withdrawn. Claims 1-33 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1-33.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

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